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/XuFan Tseng/

March 1, 2010

XuFan Tseng

Date

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appl. No. : 10/678,558  
Applicants : Thumplasseril V. John *et al.*  
Filed : October 3, 2003  
Title : Conjugated Dienamides, Methods of Production Thereof,  
Compositions Containing Same and Uses Thereof  
Art Unit : 1655  
Examiner : Catheryne Chen  
Confirmation No. : 2540  
Attorney Docket No. : IFF-63

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir/Madam:

This is responsive to the Final Office Action issued on December 28, 2009 for the above-identified application. A Notice of Appeal in compliance with 37 CFR 41.31 is concurrently filed. A shortened statutory period for reply to the Final Office Action is set to expire on March 28, 2010. This response is filed within the shortened statutory period. No extension of time is believed to be required. Applicants respectfully submit the following arguments.

## ARGUMENTS:

### **Claim Rejection Under 35 U.S.C. § 102**

Examiner repeats the assertion that “[c]laims 3-4, 40-41 are rejected under 35 U.S.C. § 102(c) as being anticipated by Nakatsu *et al.* (US 6780443 B1) for the reasons set forth in the previous Office Action . . .” (*See*, Office Action, page 2).

Applicants submit herewith the same response that has been submitted in the previous Amendments (for example, the August 29, 2009 Amendment, page 3).

1. Contrary to this Examiner’s assertion first made in the October 1, 2008 Office Action, claims 3, 4, 40, and 41 were not rejected under 35 U.S.C. § 102(c) in the previous Office Action (i.e., the March 28, 2008 Office Action). Thus, Examiner erred by introducing new ground of rejections. Examiner continues to repeat this same rejection in the June 18, 2009 and the December 28, 2009 Office Actions.

2. Nevertheless, Applicants traverse the rejection by submitting the following:

(I) There is no rationale or evidence tending to show inherency. It is submitted that Examiner has not met the inherency criteria set forth in MPEP 2112 (IV), and failed to provide “a basis in fact” (evidence) and/or reasoning tending to show inherency (*See*, the August 29, 2009 Amendment, pages 3-4).

(II) Spilanthol is distinct from the claimed invention. Contrary to the Examiner’s assertion that Applicants argued the tingling sensate of spilanthol was not taught (*See*, Office Action, page 3, line 15), Applicants repeatedly affirm the Nakatsu teaching of a tingling substance of spilanthol. However, spilanthol is distinct from the claimed invention (*See*, the August 29, 2009 Amendment, page 4).

(III) Applicants’ disclosure does not indicate extracting the claimed alkadienamides from all Piper species. Examiner also asserts “the Specification . . . indicated that the alkadienamides can be extracted from Piper species,” and concludes black piper would inherently contain the claimed alkadienamides (*See*, Office Action, page 3). Applicants clearly and specifically set forth *Piper longum* Linn and *Piper peepuloides* as the specific species for obtaining the claimed alkadienamides. There is no teaching or suggestion by the Applicants of

extracting the claimed alkadienamides from all Piper species (*See*, the August 29, 2009 Amendment, page 5).

**Claim Rejection Under 35 U.S.C. § 103**

Claims 3, 4, 40, and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakatsu *et al.* (*See*, Office Action, page 4).

Examiner sets forth the same causes as those set forth in the above § 102(c) rejection: (i) black pepper extract inherently contains the claimed alkadienamides (*See*, Office Action, page 4, 2nd paragraph); (ii) Applicants argued that tingling sensate of spilanthol was not taught (*See*, Office Action, page 5, 2nd paragraph); and (iii) Applicants' disclosure indicates that the claimed alkadienamides can be extracted from any Piper species (*See*, Office Action, page 5, 5th paragraph).

In response, Applicants submit the same arguments as those submitted in response to the above § 102(e) rejection: (i) there is no rationale or evidence tending to show inherency; (ii) spilanthol is distinct from the claimed invention; and (iii) there is no disclosure by the Applicants that the claimed alkadienamides can be extracted from any Piper species (*See*, the August 29, 2009 Amendment, page 6).

Applicants further submit that it is well known in the art that the *Piper* family contains thousands of species, different in distribution as well as chemical compositions (*See*, Specification, page 1, line 21 to page 2, line 22). Black pepper and *Piper longum* Linn both belong to the *Piper* family, however, they are distinct plants having distinctive attributes (*See*, the August 29, 2009 Amendment, page 6).

**Declaration Traversing Rejections under 37 CFR § 1.132**

To further demonstrate the distinctiveness of black pepper vs *Piper longum* Linn, Applicants filed the Declaration Traversing Rejections under 37 CFR § 1.132 (“the Declaration”) on July 2, 2008.

However, Examiner has not addressed the substance of the Declaration in any of the issued Office Action.

The Declaration shows that black pepper and *Piper longum* Linn had distinctive flavor profiles. In particular, the tingling effect differs significantly (*See*, the August 29, 2009 Amendment, page 6).

**CONCLUSION**

In view of the foregoing, Applicants respectfully request reconsideration, withdrawal of rejections, and allowance of all claims now present in the application.

The Commissioner is authorized to charge any required fees, including any extension and/or excess claim fees, any additional fees, or credit any overpayment to the Deposit Account No. 12-1295.

Respectfully submitted,

/XuFan Tseng/

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